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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/581,158	01/30/2007	Yoshinori Watanabe	4439-4043	9153
27123	7590	11/14/2008	EXAMINER	
MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			HUTSON, RICHARD G	
ART UNIT	PAPER NUMBER			
	1652			
NOTIFICATION DATE	DELIVERY MODE			
11/14/2008	ELECTRONIC			

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOPatentCommunications@Morganfinnegan.com  
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<b>Office Action Summary</b>	<b>Application No.</b> 10/581,158	<b>Applicant(s)</b> WATANABE, YOSHINORI
	<b>Examiner</b> Richard G. Hutson	<b>Art Unit</b> 1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on **21 July 2008**.  
 2a) This action is **FINAL**.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-27 is/are pending in the application.  
 4a) Of the above claim(s) 1-4 and 7-27 is/are withdrawn from consideration.  
 5) Claim(s) 5 is/are allowed.  
 6) Claim(s) 6 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/US/06)<br>Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

The art unit location of your application and examiner has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1652, Examiner Richard Hutson Ph.D.

Applicants amendment of claims 5 and 6 in the paper of 7/21/2008, is acknowledged. Claims 1-27 are still at issue and are present for examination.

Applicants' arguments filed on 7/21/2008, have been fully considered and are deemed to be persuasive to overcome some of the rejections previously applied. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn.

Claims 1-4 and 7-27 (claims 11-12, 17-18 and 23-24 are not drawn to SEQ ID NO: 2) are withdrawn for pertaining to nonelected subject matter. Claims 5-6 are presently under examination.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 6 remains rejected under 35 U.S.C. 102(e) as being anticipated by Cao et al., US Patent Application No.: US 2003/0233675, filed 2/20/2003.

This rejection was stated in the previous office action as it applied to previous claim 6. In response to this rejection applicants have amended claims 6 and traverse the rejection as it applies to the newly amended claim.

Applicants traverse this rejection on the basis that Cao et al. relates to DNA constructs, etc. comprising a polypeptide from a microbial source for use in genetic engineering of plants and the polypeptide of SEQ ID NO: 2386 indicated by the Examiner is one of 2226 polypeptides enumerated in Table 10A as a factor useful for improving homologous recombination. This SEQ ID NO: 2386 of Cao et al. corresponds to the sequence where 21 amino acids are inserted in the amino acid sequence shown by SEQ ID NO: 2 of the present invention between Lys at the 34th position and Lys at the 35th position.

Applicants submit that Cao et al. is silent about the function of the polypeptide of SEQ ID NO: 2386 but mention SEQ ID NO: 2386 as a factor for improving homologous recombination, so that even a skilled artisan would be unable to predict from Cao et al. that SEQ ID NO: 2386 is a protein having a chromosome-suppression activity.

Applicants complete argument is acknowledged and has been carefully considered, however, is not found persuasive for the reasons previously made of record and repeated herein. Cao et al. teaches the polypeptide 2386, which is encoded by a DNA hybridizing with the antisense strand of a DNA encoding the amino acid sequence

of SEQ ID NO:2 under stringent conditions. While Cao et al. do not teach that this polypeptide has a regulatory activity of chromosome segregation, this function is considered inherent to the protein taught by Cao et al. based upon the high degree of homology between the amino acid sequence of this protein and that of SEQ ID NO:2. Further as applicants have suggested Cao et al. do teach that this protein is useful for improving homologous recombination, which may be through chromosome segregation.

Thus claim 6 remains rejected under 35 U.S.C. 102(e) as being anticipated by Cao et al.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard G. Hutson whose telephone number is 571-272-0930. The examiner can normally be reached on M-F, 7:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nashaat T. Nashed can be reached on 571-272-0934. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

rgh  
11/9/2008

/Richard G Hutson/  
Primary Examiner, Art Unit 1652